

Application No. 10/620,749
Request for Reconsideration dated 17 January 2005
Reply to Office Action dated 18 November 2004

Attorney Docket No. 5701-01293

Remarks

Applicant respectfully requests reconsideration of the objection to the specification in view of the following remarks.

Specification

The Examiner has stated that the specification is missing the following sections:

(e) BACKGROUND OF THE INVENTION

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98

(f) BRIEF SUMMARY OF THE INVENTION

Applicant respectfully submits that neither a BACKGROUND OF THE INVENTION nor a BRIEF SUMMARY OF THE INVENTION are required, and that the outline of sections suggested by the Examiner is a guideline illustrating a preferred layout, but which is not mandatory. Applicant respectfully submits that the specification does satisfy the mandatory and controlling requirements of 35 USC §112 and the Rules of Practice.

More particularly, Applicant respectfully requests reconsideration of the objection to the specification for the following reasons:

1. The Examiner has interpreted as mandatory, provisions of the rules that in fact are optional;
2. There is no requirement to provide a description of related art;
3. BACKGROUND OF THE INVENTION and BRIEF SUMMARY OF THE INVENTION sections are not required, and have never been required, in electronically filed patent applications; and
4. The undersigned has prosecuted a score of issued U.S. patents that do not incorporate either a BACKGROUND OF THE INVENTION or a BRIEF SUMMARY OF THE INVENTION; these sections were not considered mandatory in those U.S. patent applications by the many and varied examiners who issued them.

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1. The Examiner has interpreted as mandatory, provisions of the rules that in fact are optional

Applicant respectfully submits that the Examiner appears to have explicitly asserted that recitations of "should" in 37 CFR 1.77(b) are interpreted to mean "must". Applicant respectfully submits that the mandatory sections of the Rules of Practice already incorporate associated mandatory language such as "must" or "required", so that if Rule 37 CFR 1.77(b) was intended to be absolutely mandatory, then that rule would have been drafted with mandatory language. Instead, applicant respectfully submits that the word "should" in 37 CFR 1.77(b) is conditioned by 37 CFR § 1.77(c) which states as follows:

(c) The text of the specification sections defined in paragraphs (b)(1) through (b)(11) of this section, **if applicable**, should be preceded by a section heading in uppercase and without underlining or bold type. (emphasis added)

Applicant respectfully submits Rule 37 CFR § 1.77(b) provides for the order of sections when those sections have been incorporated into the application, but does not otherwise mandate the incorporation into the application of a particular section enumerated in 37 CFR 1.77 §§ (b)(1) through (b)(11).

Whether or not a section of a patent application is required is governed by either Law or associated mandatory language of the Rules. The content of an application is governed by the laws of 35 USC §§ 111 and 112 which state, *inter alia*, as follows:

35 USC § 111(2): CONTENTS.—Such application shall include—

- (A) **a specification as prescribed by section 112 of this title;**
- (B) a drawing as prescribed by section 113 of this title; and
- (C) an oath by the applicant as prescribed by section 115 of this title.
(emphasis added)

35 USC § 112, first paragraph: The specification shall contain a **written description** of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. (emphasis added)

The law of 35 USC § 111 is implemented by Rules 37 CFR §§ 1.51 and 1.53, which state, *inter alia*, as follows:

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§ 1.51 General requisites of an application.

(b) A complete application filed under § 1.53(b) or § 1.53(d) comprises:

- (1) A specification as prescribed by 35 U.S.C. 112, including a claim or claims, see §§ 1.71 to 1.77;
- (2) An oath or declaration, see §§ 1.63 and 1.68;
- (3) Drawings, when necessary, see §§ 1.81 to 1.85; and
- (4) The prescribed filing fee, see § 1.16. (emphasis added)

§ 1.53 Application number, filing date, and completion of application.

(b) Application filing requirements -Nonprovisional application. The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. ... (emphasis added)

Rule 37 CFR § 1.71 -- which applies to the detailed description and specification -- is mandatory under § 1.53(b) based upon 35 USC § 112; and the associated wording of § 1.71 uses corresponding mandatory language, as follows

§ 1.71 Detailed description and specification of the invention.

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same. (emphasis added)

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth. (emphasis added)

...

Significantly, § 1.71 does not mention or require a BACKGROUND OF THE INVENTION or a BRIEF SUMMARY OF THE INVENTION.

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Similarly, 37 CFR § 1.75 -- which applies to the claims -- is also mandatory under § 1.53(b) based upon 35 USC § 112, and the associated wording of § 1.75 uses corresponding mandatory language ("must") where provided for by 35 USC § 112, as follows:

§ 1.75 Claim(s).

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery. (emphasis added)

Rule 37 CFR § 1.72 -- which applies to the title and abstract -- is also mandatory, as follows:

§ 1.72 Title and abstract.

(a) The title of the invention may not exceed 500 characters in length and must be as short and specific as possible. ...

(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." ... (emphasis added)

Rule 37 CFR § 1.73 provides the requirements of a Summary of the invention when such summary is set forth, as follows:

§ 1.73 Summary of the invention.

A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

Accordingly § 1.73 is not mandatory in respect of the inclusion of a BRIEF SUMMARY OF THE INVENTION, but provides the requirements thereof if a BRIEF SUMMARY OF THE INVENTION were to be provided. In the case of the instant application, because a separate BRIEF SUMMARY OF THE INVENTION has not been provided, then Applicant respectfully submits that § 1.73 would not apply to the instant application.

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Accordingly, the Examiner's present insistence upon the inclusion of a BACKGROUND OF THE INVENTION and a BRIEF SUMMARY OF THE INVENTION appears to be exclusively based upon Rule 37 CFR § 1.77, in which §1.77(b)(1) through b(11) provides for an arrangement of application elements. However, 37 CFR § 1.77(b) would appear to be governed by 37 CFR § 1.77(c), which states as follows:

(c) The text of the specification sections defined in paragraphs (b)(1) through (b)(11) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type. (emphasis added)

Accordingly, 37 CFR § 1.77 contemplates that some of the sections listed in paragraphs (b)(1) through (b)(11) thereof may not be applicable, which would mean that these sections might not otherwise be included in a particular patent application. For example, a "Cross-reference to related applications" ((b)(2)) would obviously not be necessary if there were no related applications, and a "Sequence Listing" (b)(11) would obviously not be necessary if the invention did not comprise a biological sequence. Drawings may also not be required (37 CFR § 1.74: "When there are drawings") The sections "Background of the invention" (b)(5) and "Brief summary of the invention" (b)(6) are not afforded a status that differs from any other section, and are not required by associated mandatory language in any other rule. Accordingly these sections would similarly also be optional. This interpretation is consistent with MPEP § 601 which states on page 600-3 (Rev. 2, May 2004) -- prior to the listing of the various possible section headings (A)-(K) -- as follows:

The following guidelines illustrate the preferred layout and content of patent applications filed under 35 U.S.C. 111(a). These guidelines are suggested for the applicant's use. See also 37 CFR 1.77 and MPEP 608.01(a). ... The following order of arrangement is preferable in framing the specification. See also MPEP 608.01(a). (emphasis added)

Accordingly, Applicant respectfully submits that 37 CFR § 1.77 as interpreted by MPEP § 601 provides guidelines that are suggested and may be preferred, but are not necessarily mandatory unless so stated by another Rule, e.g. as has been so stated for the **Title, Abstract, Detailed Description and at least one Claim.**

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Rules 37 CFR §§ 1.71 through 1.77 use mandatory language ("must" or "required") for mandatory provisions, and otherwise uses non-mandatory language ("may", "should") where the associate provisions are not mandatory, but instead are optional or conditional. Because there is no mandatory language actually used in the Rules in respect of a BACKGROUND OF THE INVENTION and a BRIEF SUMMARY OF THE INVENTION, Applicant respectfully submits that the Examiner should not, and may not, read mandatory language into 37 CFR § 1.77(b) with respect to a BACKGROUND OF THE INVENTION and a BRIEF SUMMARY OF THE INVENTION in the instant application. Applicant respectfully requests reconsideration and withdrawal of the Examiner's objection to the specification as presently drafted.

2. There is no requirement to provide a description of related art

The Examiner appears to have indicated that a BACKGROUND OF THE INVENTION must include "a description of related art including information disclosed under 37 CFR 1.97 and 1.98". Applicant respectfully submits that the Information Disclosure Statements submitted under 37 CFR §§ 1.97 and 1.98 are sufficient in and of themselves, and that there is no requirement for the Applicant to provide any further discussion of the prior art submitted therewith if such submissions are in the English language. MPEP §609 (page 600-129 of Rev. 2, May 2004) states that that "[t]he requirement for a concise explanation of relevance is limited to information not in the English language", a point that is also emphasized in a paragraph thereinabove. Accordingly, Applicant respectfully chooses to not provide a description of related art in any section of the patent application.

3. BACKGROUND OF THE INVENTION and BRIEF SUMMARY OF THE INVENTION sections are not required, and have never been required, in electronically filed patent applications in the USPTO

The only sections of a patent application indicated as being mandatory or required for electronically filed patent applications are the Title, Detailed Description, Claims and the Abstract. Included herewith in attached Exhibits 1-3 are the copies of pages from the associated Help files for the heretofore three generations of electronic filing programs that have been used by the USPTO, as follows:

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Exhibit 1: PASAT - the "Background of Invention" and "Summary of Invention" sections are explicitly indicated as being optional.

Exhibit 2: ABX (Version 1.1, July 2004) - there is no mention of BACKGROUND OF THE INVENTION or BRIEF SUMMARY OF THE INVENTION sections.

Exhibit 3: ABX (Version 1.2, November 2004 - current version) - there is no mention of BACKGROUND OF THE INVENTION or BRIEF SUMMARY OF THE INVENTION sections.

In May 2001, the undersigned attended a USPTO Educational Workshops on Electronic Filing and the AIPA held in Troy, Michigan, and was advised by Mr. Robert Spar of the USPTO that headings can be deleted from files constructed using PASAT, so that one need not conform to what the USPTO considers to be a preferred organization of the specification.

4. The undersigned has prosecuted a score of issued U.S. patents that do not incorporate either a BACKGROUND OF THE INVENTION or a BRIEF SUMMARY OF THE INVENTION; these sections were not considered mandatory in those U.S. patent applications by the many and varied examiners who issued them

The following twenty-seven issued U.S. patents prosecuted by the undersigned do not contain either a BACKGROUND OF THE INVENTION or a BRIEF SUMMARY OF THE INVENTION:

| | | | | |
|-----------|-----------|-----------|-----------|-----------|
| 6,317,048 | 6,378,900 | 6,392,542 | 6,407,660 | 6,420,997 |
| 6,424,319 | 6,433,688 | 6,445,294 | 6,470,272 | 6,529,811 |
| 6,552,662 | 6,583,616 | 6,586,926 | 6,587,048 | 6,606,077 |
| 6,609,055 | 6,631,776 | 6,644,688 | 6,678,095 | 6,703,845 |
| 6,777,927 | 6,825,765 | | | |

These patents were examined by various examiners supervised by various supervisory examiners in a variety of technology art units of the USPTO. Accordingly, given the issuance of these patents, they are powerful evidence that a U.S. patent need not include a BACKGROUND OF THE INVENTION or a BRIEF SUMMARY OF THE INVENTION. It would appear that the Examiner is in a very small minority in his view that these sections are mandatory in U.S. patent applications.

In view of the above remarks and submissions, Applicant respectfully requests reconsideration and withdrawal of the objection to the specification as presently drafted.

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Claim Status

Claims 1-37 are pending in the application.

Claims 1-6 and 29-31 have been cancelled.

Claims 7-28 have been allowed.

Claims 32-37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,279,944 B1 to Russell et al.

Claim Rejections Under 35 U.S.C. § 102(e)

Claims 32-37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,279,944 B1 to Russell et al.

In respect of claim 32, this claim was previously amended to add the limitation that the processor is adapted "to determine in which of a plurality of lanes the target vehicle is likely traveling." Applicant respectfully submits -- and had previously argued -- that, as best understood, Russell et al. does not disclose or suggest the determination of which of a plurality of lanes that the target vehicle is likely traveling, but instead provides for classifying each object as either in or out of the highway lane of the host vehicle.

In reply, the Examiner stated that because "Russel determines if the target vehicle ahead of the host vehicle is traveling in the same lane or not", that "[o]n a road that has only two lanes (which reads on the claim language ('plurality of lanes') Russel's system can detect if the target vehicle is on the same lane or not (the other lane)", so that "[t]herefore, Russel does determine the claimed determination in which of a plurality of lanes the target vehicle is likely traveling (depending on the number of lanes)".

Applicant respectfully disagrees with this conclusion, and respectfully requests the Examiner's consideration of the following argument: The determination of which of a plurality of lanes that the target vehicle is likely traveling is substantially different from the classification of an object as either in or out of the highway lane of the host vehicle. For example, with a two lane road, the target vehicle could be in any of the following locations: 1) in the roadway lane adjacent to the host vehicle, 2) in the roadway lane of the host vehicle, or 3) in neither the roadway lane of the host vehicle or the roadway lane adjacent to the host vehicle (i.e. off of both

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roadway lanes, e.g. on one shoulder or the other). In this case, it would appear that the invention of Russell et al. would not be able to distinguish between scenarios 1 and 3 above, whereas the instant invention could, because the instant invention provides for determining which lane the target vehicle is traveling or located. If the instant invention determined that a target vehicle was not likely traveling in either lane of a two lane road, then the instant invention could infer that the target vehicle was likely off the roadway, e.g. on a shoulder of the roadway.

Because Russell et al. does not disclose or suggest all of the limitations of claim 32, Applicant respectfully submits that claim 32 is now allowable over Russell et al. Applicant respectfully requests reconsideration and allowance of amended claim 32 in view of the above argument.

Claims 33/32, 34/1, 35/32, 36/35/32 and 37/36/35/32 each depend upon claim 32. Accordingly, Applicant respectfully submits that if the above argument regarding the novelty of claim 32 in view of Russell et al. is accepted, then claims 32-37 are also distinguished from Russell et al. because the addition of further limitations to an already novel claim does not negate novelty. Applicant respectfully requests reconsideration and allowance of claims 32-37 in view of the above argument in respect of claim 32 in view of Russell et al.

Summary and Conclusions

Applicant respectfully requests reconsideration of the objections to the specification and the rejections of claims 32-37 in view of the remarks hereinabove. Applicant respectfully submits that the instant application is now in the proper form for Notice of Allowance, and respectfully requests a timely issuance thereof in this application.

Respectfully Submitted,



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